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REMARKS

Turning to the rejections presented in the final Office Action, the Examiner repeats verbatim the rejections presented in the prior Office Action of January 22, 2004. Thus, Claims 1, 11 and 18-21 were rejected under 35 U.S.C. §112(¶1) as purportedly failing to comply with the enablement requirement. (Final Office Action, ¶2) Claims 1-6, 9-15 and 18-21 were rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,635,088 B1 to Hind, et al. (Final Office Action, ¶4) Claims 7-8 and 16-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hind in view of U.S. Patent No. 6,175,820 B1 to Dietz. (Final Office Action, ¶6)

In addition, in paragraph 7 of the final Office Action, the Examiner responds to certain arguments presented in the prior Amendment Under 37 C.F.R. 1.111 of April 9, 2004 relating to the §112(¶1) rejection.

Claim 1 is properly enabled under §112(¶1). Evaluation of a claim under §112(¶1) determines whether the scope of a claim is commensurate with the scope of enablement of the disclosure. MPEP 2164.08. In making the §112(¶1) rejections in paragraphs 2 and 7 of the final Office Action, the Examiner notes that data is compressed and asserts that this in itself is a change of format of

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the document.¹ The Examiner also states in paragraph 7 that after compression "the structure is substantially similar". This demonstrates the Examiner's understanding is that 1) the document is compressed (which the Examiner also asserts is a change of format) and 2) the document reflects no other change of format after compression.

Thus, the Examiner acknowledges, in substance, that the pertinent scope of Claim 1 is that the document after compression is in a compressed state of the format of the document before compression. Express application of factors given in MPEP 2164.08 also yields the pertinent scope of Claim 1: Claim 1 recites "compressing only said data elements" in the document and that the document is in "a given file format" both before and after compression. Taken as a whole, this clearly means that the document is in the given format before compression and in a compressed state of the given format after compression. This is also completely consistent with the teachings throughout the specification.

Once the scope is determined, MPEP 2164.08 inquires whether the scope is enabled by the specification. The teachings throughout the specification also unquestionably enable the

¹ Applicant does not concede that compression is considered in the art to be a change of format and has referred to the document after compression as being in the "same" format.

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pertinent scope of Claim 1 noted above (namely, that the document after compression is in a compressed state of the format of the document before compression). For example, without limiting the scope of the claims, pages 6-7 of the specification describes an exemplary embodiment using the WinZip compression algorithm for compressing the data fields of an XML document, resulting in a compressed XML document. Thus, the specification properly enables the relevant scope of Claim 1. Accordingly, withdrawal of the §112(¶1) rejection of Claim 1 is respectfully requested.

Applicant suggested in the prior Amendment that the Examiner may have meant to raise the issue of indefiniteness rather than enablement. The remark that the claim is "not consistence" in paragraph 7 of the final Office Action further suggests this may be the Examiner's intent. Even so, a proper analysis under §112(¶2) indicates that Claim 1 is also sufficiently precise. MPEP 2173.02, for example, instructs that the Examiner "should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness" (emphasis in original) and that "[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire". Under MPEP 2173.02, definiteness is analyzed in light of the disclosure, the interpretation of the claim that would be given by one having the

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ordinary level of skill in the art at the time the invention was made, and the prior art.

Application of these factors demonstrates that Claim 1 is sufficiently definite: In the same manner as discussed above, a person possessing the ordinary level of skill in the art at the time of the invention (as well as today) considering the pertinent recitations of Claim 1 would clearly understand that the document is in a given format before compression and in a compressed state of the given format after compression. In addition, as noted in the prior Amendment, the specification and figures render apparent the meaning of "a given file format" after compression, namely one having the same format in a compressed state. Also, it was noted that the Hind patent (cited by the Examiner) refers to a "compressed XML file" (Hind, col. 3, lines 24-48). Thus, the "wherein" clause of Claim 1 is sufficiently definite under MPEP 2173.02.²

For at least the above-noted reasons, the scope of the recitation "wherein said document before and after the compressing step is in a given file format" is enabled under §112(¶1) and is

² Paragraphs 2 and 7 of the final Office Action are largely unclear and inconsistent (as exemplified in footnote 3). Also, the Examiner provides no authoritative basis for asserting that compression is a change of format, and thus no support for his belief that the wherein clause is inconsistent or in need of clarification. More importantly, the pertinent analysis under MPEP 2173.02 demonstrates that the claims are reasonably definite.

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furthermore sufficiently clear under §112(¶2). Withdrawal of the rejection of Claim 1 under §112(¶1) is respectfully requested.³ By analogous reasoning, withdrawal of the rejections of Claims 11 and 18-21 under §112(¶1) is likewise respectfully requested.

Turning to the art rejections given in paragraphs 4 and 6 of the final Office Action, the final Office Action repeats verbatim the rejections given in the prior Office Action of January 22, 2004. In addition, the "Response to Arguments" portion of the final Office Action fails to address the arguments that Applicant previously presented in the April 9, 2004 Amendment to distinguish the art.

Under MPEP 706.07, the Examiner should have addressed those arguments in the final Office Action. MPEP 706.07 explicitly states that a rebuttal of any arguments should be included in the final Office Action. MPEP 706.07 also directs that the prosecution

³ Applicant fails to understand the Examiner's statement "the common term "format" is analogous to hierarchical" in paragraph 7. Applicant's prior remark was that the specification does not state or imply that the term "format" generally refers to a "hierarchical structure". This was in response to the Examiner's statement "Applicant indicates in the specification that the term "format" refers to a hierarchical structure" made in paragraph 2. (As to any other possible interpretations of the Examiner's paragraph 2 statement, Applicant simply notes that the specification speaks for itself.) In addition, the Examiner states in paragraph 7 that "format" is used to describe the arrangement of data and that it "therefore" follows that the wherein clause of Claim 1 is inconsistent. The Examiner fails to explain how, from such an understanding of the term "format", he concludes that compression results in a change of format. The Examiner also fails to reconcile (or support) his later assertion in paragraph 7 that "[t]he same format implies that both formats include the same size, structure, and integrity".

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should not be cut off prematurely and that clear issues should be developed whenever possible before appeal.

As to the rejections of independent Claims 1, 11 and 18-21 as anticipated by Hind, the material cited in paragraph 4 of the Office Action from col. 13 of Hind actually shows compression of the tags of an XML document. By contrast, Claim 1 recites "compressing only said data elements in said document", with like recitations for Claims 11, and 18-21. Thus, the Office Action fails to present a case of anticipation of independent Claims 1, 11 and 18-21 based on the cited aspects of Hind.

In addition, independent Claims 1, 11 and 18-21 are distinguishable from the "first aspect" of Hind at col. 8, line 19, et seq.⁴ Reference is made to the summary of Hind's "first aspect" given on page 12 of the prior Amendment. Distinction between Hind's "first aspect" and Claim 1 is found in at least the Claim 1 recitation of "a compression algorithm that has a corresponding decompression facet". Similar distinctions apply for Claims 18 and 20, while recitation relating to the "identifier" of the compression algorithm distinguishes Claims 11, 19 and 21 from Hind's "first aspect".

For at least these reasons, Claims 1, 11 and 18-21 are

⁴ It is noted that Hind's "first aspect" was raised by Applicant in the prior Amendment, and Claims 1, 18 and 20 were amended to further clarify the distinction between them and Hind's "first aspect".

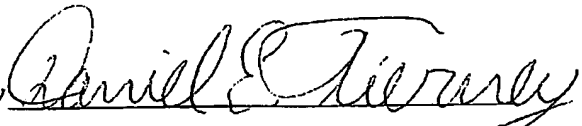
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patentably distinct from Hind.

The secondary reference Dietz is cited in paragraph 6 of the Office Action with respect to Claims 7, 8, 16 and 17 for purportedly showing a speech recognition system, not for the elements missing from Hind with respect to the independent Claims. Dependent Claims 2-6, 9, 10 and 12-15 (also rejected as anticipated by Hind) are distinguishable from Hind at least based on their dependencies on their respective independent claim. Finally, for the above-noted reasons the Office Action fails to present a prima facie case of obviousness with respect to dependent Claims 7-8 and 16-17 based on Hind and Dietz under MPEP 2143.03.

For at least the above-noted reasons, reconsideration and allowance of Claims 1-21 is respectfully requested. Should the Examiner not accept Applicant's arguments, it is respectfully requested that the Examiner withdraw the finality of the current Office Action and present any rebuttal arguments he may have, so that the Examiner's position is on the record for appeal.

Respectfully submitted,

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